

Remarks/Arguments for  
Pre-Appeal Brief Request

Doc Code: AP.PREBREQ

Customized Form PTO/SB/33 (07-05)

**PRE-APPEAL BRIEF  
REQUEST FOR REVIEW**

Application #	10/784,812
Confirmation #	1182
Filing Date	02/24/2004
First Inventor	HOCKMAN
Art Unit	3635
Examiner	Chapman, Jeanette E.
Docket #	P07698US00/WEJ

Applicant requests review of the final rejection in the above-identified application.  
No amendments are being filed with this request.

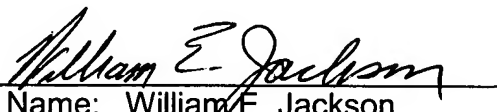
This request is being filed with a NOTICE OF APPEAL.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the Attorney of Record.

Date: March 28, 2007

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## REMARKS AND ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Office Action dated October 12, 2006, applicant filed a request for reconsideration on January 31, 2007. No Advisory Action has been issued.

### I. Claim Rejections Under 35 U.S.C. §112

The Official Action rejects claims 1 and 7 under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. The Official Action asserts that ““The spanning means and the means for connecting being located below the top of adjacent seams” and “the pipe mounted close to the surface of the base portion of the roof surface” is essential to the practice of the invention, but not included in and not enabled by the disclosure.” (Emphasis added). Applicant respectfully traverses the Examiner’s assertions and respectfully points out below that there is, in fact, enabling disclosure found in various portions of the application, specification and drawings.

The Examiner’s attention is directed to the following quotations from the Applicant’s original specification:

At page 4, paragraph 0010, bridging over to page 5 it is stated: “The end result of the present invention is that the pipe is mounted parallel to the surface of the roof and below the height of the raised portions of the roof.” (Emphasis added).

Page 6, paragraph 0023 states: “A partial cross-sectional view of Fig. 1 is illustrated in Fig. 3 which shows bosses B<sub>1</sub>, B<sub>2</sub> formed at the side portions of the snow brake base 107. The bosses B<sub>1</sub> and B<sub>2</sub> are formed close enough to the bottom of the snow brake base 107 so that the interconnected pipes 109 are located between the rolled seams. Thus, pipe 109 is located close enough to the roofing surface to block the passage of snow and ice but far enough away to allow for melting snow or rain water to pass beneath the pipe 109.” (Emphasis added).

Page 7, paragraph 0026, states: “Fig. 2B and Fig. 4 illustrate a further embodiment of the present invention wherein depressions D<sub>1</sub> and D<sub>2</sub> are defined on the sides of the snow brake base 107 and pipes 109 are dimensioned to be inserted into the depressions.”

Referring to Figure 4 of the application drawings, it should be clear that the depressions  $D_1$  and  $D_2$  are configured and sized to fall below the top of the vertical seam formed between elements 101 and 103. Thus, it is clear that the pipe inserted into opening  $D_2$  is located below the top of the adjacent vertical seams and is also mounted close to the surface of the base portion of the roof surface 101.

In view of the above express disclosure including the drawings and the written description thereof, it is clear that there is enabling disclosure present for claims 1 and 7 and that the rejection under the first paragraph of § 112 is not well taken.

Reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner has also rejected claims 1 and 7 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner's rejection is based upon the same erroneous factual assertions pertaining to the alleged absence of sufficient teachings in the specification. Because the specification expressly and clearly explains the location of the spanning means to be located below the top of adjacent seams and for the pipe to be mounted close to the surface of the base portion of the roof surface, it is respectfully submitted that the rejection under second paragraph of § 112 is not well taken and should be withdrawn. Reconsideration and withdrawal are respectfully requested.

## **II. The Rejection Under 35 U.S.C. § 101**

Claims 7 thru 8 stand "provisionally rejected under 35 U.S.C 101 as claiming the same invention as that of claims 1-8 of co-pending Application No. 10/784,812."

(Emphasis added). For the following reasons this rejection is in error and should be withdrawn.

First, the alleged “co-pending application” serial number is identical to the serial number of the present application. Thus, the Examiner is in reality rejecting claims 7 and 8 of the present application over claims 1 and 8 of the present application. This is illogical and is not authorized under the pertinent statutes and case law. Applicant assumes that the Examiner meant to make reference to co-pending application Serial No. 10/898,552. Even if that assumption is made, the rejection also is illogical and should be reconsidered and withdrawn since on or about May 17, 2006, in response to the Office Action dated March 30, 2006 in Serial No. 10/898,552, Applicant requested that claims 1 thru 8 of the co-pending application be cancelled “without prejudice.” See the response After Final Rejection dated May 17, 2006, filed in Serial No. 10/898,552 (copy attached to Paper dated Jan. 31, 2007). Accordingly, Applicant respectfully requests reconsideration of the alleged rejection of double patenting under 35 U.S.C. § 101 based on claims no longer in the co-pending application.

Claims 1 through 6 of the present application stand “provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-6 of co-pending Application Serial No. 10/898,552. As discussed above, it is believed that the Examiner has erred in making this alleged rejection because claims 1 thru 6 of the co-pending application Serial No. 10/898,552 were cancelled on May 17, 2006. Accordingly, the provisional double patenting rejection of claims 1 through 6 based upon the obviousness-type double patenting is in error. Applicant respectfully requests reconsideration and withdrawal.

Applicant wishes to note for the Examiner that application claims 9 thru 13 of his co-pending Serial No. 10/898,552 have been allowed and the issue and publication fees were paid on or about November 29, 2006. (See PTOL 85 attached to Paper dated Jan. 31, 2007).

### **III. Summary**

In view of the above, it is respectfully submitted that the final rejections of claims 1 through 8 are clearly in error, should be reconsidered and withdrawn because they are based upon alleged facts that are incorrect.

Reconsideration and allowance is respectfully requested.